

REMARKS

Claims 16 and 28 stand rejected under 35 U.S.C. 112, first paragraph as lacking appropriate support. Claims 16, 21 and 24-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over patent No. WO 01/20855 (hereinafter Etsuo) in view of US patent No. 6,988,129 (hereinafter Quine). Claim 23 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Etsuo in view of Quine and further in view of JP 11232188 (hereinafter Yoshihiro). Applicant respectfully requests reconsideration of the rejections, and further requests allowance of the pending claims in view of the foregoing amendments and the following remarks.

Claims 1-15, 17-20 and 22 were previously canceled. Claims 16, 21, and 23-30 are presently pending.

Claims 16 and 28 have been amended to moot the 112, first paragraph issue noted in the Office Communication. Accordingly, this basis of rejection should be withdrawn.

Claim 16 is directed to a method for transmitting messages in a network via data terminals connected thereto. For the convenience of the reader, the reference numerals below refer to FIGs. 1 and 2 of the drawings of the present invention.

A message 14 to be relayed is sent from a sender data terminal to a first mail processing device 2 assigned to the sender data terminal. A unique identifier is assigned to the message that indicates that a message to be relayed is on the sender data terminal or in the first mail processing device. The identifier comprises a plurality of subidentifiers, each of which is assigned to at least one message element contained in a relayed message. A test message 6 including the subidentifiers is sent from the first mail processing device 2 to a second mail processing device 4 assigned to a recipient address data terminal. The second mail processing device 4 evaluates the test message 6 sent by the first mail processing device 2. The evaluating is configured to process each subidentifier in the test message relative to data present in the second mail processing device indicative of respective message elements previously relayed to the recipient address data terminal. An evaluation-result message 7 is sent from the second mail processing device 4 to the first mail processing device 2. The evaluation-result message 7 indicates to the first mail processing device 2 to transmit message elements or to block message elements from being transmitted to the second mail processing device. More particularly, message elements evaluated as not previously relayed to the recipient address data terminal are

transmitted to the second mail processing device, and message elements evaluated as previously relayed to the recipient address data terminal are blocked. A transmission 8 is performed of respective ones of the message elements to the second mail processing device in response to the evaluation-result message. Message elements transmitted from the first mail processing device 2 to the second mail processing device 4 are relayed to the recipient address data terminal respective.

It is respectfully submitted that neither Etsuo nor Quine, singly and in combination, teach or suggest each of the structural and/or operational relationships of the claimed invention. The Office Communication construes component 300 of Etsuo as the first mail processing device 2 assigned to the sender data terminal. The Office Communication nowhere identifies any component of Etsuo that functions as a second mail processing device 4 assigned to a recipient address data terminal. Consequently, Etsuo cannot perform any of the operational interrelationships set forth in the claimed invention between first mail processing device 2 and second mail processing device 4.

The Office Communication cites the following excerpt of Quine in an attempt to correct the glaring deficiencies of Etsuo regarding the claimed invention.

The notifications 901 to the selected correspondents preferably include an explanation 902 of the e-mail forwarding service provided in accordance with the present invention, and possibly include instructions on how to become a subscriber. Preferably the notification 901 will include a button or a hot link 903 to allow the recipient to easily access a registration interface, such as the one depicted in FIG. 8B. Preferably, prior to sending the notifications to the selected recipients, the e-mail forwarding system 44 will send a test message to the new subscriber to confirm that the new address is correct.

Apparently the approach used was merely to find a hit for the phrase “test message” without establishing a logical relevance. More particularly, one skilled in the art will appreciate that the test message of Quine has no logical nexus whatsoever in connection with the operational interrelationships set forth in the claimed invention. The Examiner as justification for applying Quine states that the suggestion/motivation of the combination would have been “*to make sure that the new address is correct*”. However, this purported motivation utterly misses the results that flow from the claimed structural and operational interrelationships that allow to evaluate whether a message element is transmitted or blocked to a recipient. This has nothing to do with making sure that any address is

correct. Therefore, it is respectfully submitted that the Examiner has failed to meet the burden required by the statute and applicable rules to establish *a prima facie* case of obviousness. Consequently, this basis of rejection over Etsuo and Quine should be withdrawn and allowance of claim 16 (and claims depending there from) are solicited.

In connection with dependent claim 23, it is respectfully noted that Yoshihiro fails to remedy the fundamental deficiencies of the Quine/Etsuo combination. Consequently, this claim is also allowable over the applied art.

Independent claim 28 is directed to a network and, in view of the discussion above, it is respectfully submitted that claim 28 is also patentable over Etsuo and Quine and allowance of claim 28 (and claims depending there from) is similarly requested.

Conclusion

It is respectfully submitted that each of the claims pending in this application recites patentable subject matter and it is further submitted that such claims comply with all statutory requirements and thus each of such claims should be allowed.

The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including the fees specified in 37 C.F.R. §§ 1.16 (c), 1.17(a)(1) and 1.20(d), or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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